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EXAMINER

WORJLOH, JALATEE

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3621

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/578,751
Filing Date: May 25, 2000
Appellant(s): SHRADER ET AL.

James O. Skarsten (Registration No. 28, 346)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 10, 2006 appealing from the Office action mailed February 7, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6785671

BAILEY

8-2004

Muller, Nathan J., Desktop Encyclopedia of the Internet, Artech House, Inc., 1998

Website printout from www.Streetprices.com, 1/25/99 ("Streetprices 1/99")

Gralla, Preston, How the Internet Works, Millennium Ed., Que Corporation, 8/1999

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC §102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Applicants are reminded that it is inappropriate for the USPTO to disregard any relevant evidence of record. “It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included.” *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, the USPTO uses the preponderance of the evidence standard.¹ In light of this standard, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) (“All the evidence on the question of obviousness must be considered.”); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]”); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) (“Patentability *vel non* is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all* the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would

¹ See MPEP §706 I. “The standard to be applied in *all* cases is the ‘preponderance of the evidence’ test. In other words, an examiner should reject a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable. [Emphasis added.]”

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have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does *not* consider all relevant evidence of record may not be supported by the required substantial evidence² since the particular evidence *not* considered may be probative of a factual issue presented. Forth, prior art patents are not technical treatises and therefore these patents intentionally omit features that are known in the field of the invention. See *S3 Inc. v. nVIDIA Corp.*, 259 F.3d at 1371, 59 USPQ2d at 1749-50 (“The law is clear that patent documents need not include subject matter that is known in the field of the invention and is in the prior art, for patents are written for persons experienced in the field of the invention. ... To hold otherwise would require every patent document to include a technical treatise for the unskilled reader.”); and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999) (“The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel.”). Finally and perhaps most importantly, it is well established that “[a] reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.* [Emphasis in original.]’” *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and noting that regarding the claimed “simultaneously monitoring the selected multiple connection points,” the prior art “nevertheless anticipates [the claimed invention], even if it does not specifically disclose simultaneous monitoring of the output points, if simultaneous or parallel monitoring is within the knowledge of a skilled artisan.” *Graves*, 69 F.3d at 1152, 36 USPQ2d at 1701.³ Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, because any evidence or record *not* considered by the USPTO may be probative of at least one factual issue presented, because prior art patents need not include subject matter that is known in the field of the invention, and because anticipation is determined by the teachings of a reference in combination with the knowledge of one of ordinary skill in the art, that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—are based upon the cited reference(s) in the statement of the rejection in combination with the knowledge of one of ordinary skill in this art.

2. Claims 1-14, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Streetprices.com (website printout of January 25, 1999) (“Streetprices

² See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000) where the Federal Circuit concluded that USPTO’s factual findings must be supported by substantial evidence.

³ See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) for the same statement of law and also citing *In re LeGrice*; and *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (B.P.A.I. 1992).

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1/99"). Streetprices 1/99 discloses generating a set of product profiles (see e.g. "Computers", "Flowers" and "Toys"), each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in HTML and XML; periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level).

Claim Rejections - 35 USC §103

3. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Streetprices 1/99 in view of Bailey et. al. (U.S. 6,785,671)("Bailey"), Muller's Desktop Encyclopedia of the Internet ("Muller"), and Gralla's How the Internet Works ("Gralla").⁴ It is the Examiner's principle position that the claims are anticipated because the parsing is inherent and a profile identify a given a site URL is also inherent.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 as taught by Bailey to

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include Bailey's parsing. Such a modification would have simply disclosed a feature that is already inherent in Bailey.

Regarding the generating the profile identifying a given site URL, this too is inherent in web crawler program. If web crawler programs do not generate an object, list, or profile identifying a given URL, that particular URL cannot be searched.

5. In this particular rejection, Muller and Gralla are cited simply to show those features of the Internet that are old and well known in the art yet silent in Streetprices 1/99 and Bailey.

6. Additionally, if the sever structure was not inherent, it too would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 to include generating at the client computer a profile. It is the Examiner's position that absent evidence of new or unexpected results, it is not inventive in terms of patentability to take one or more clients or servers ($S_1, S_2, S_3, \dots S_N$) which perform one or more tasks ($T_1, T_2, T_3, \dots T_N$) and add (or subtract) an additional number of servers (X) to perform all or part of the same tasks by allocating the tasks between the various clients and servers (*i.e.* S_1 and S_{N+1} perform T_1 ; S_2 and S_{N+2} perform T_2 ; S_3 and S_{N+3} perform T_3 ; ... while S_N and S_{N+X} perform T_N). The prior art is replete with examples showing why user various client server configurations are desirable.⁵

⁴ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

⁵ See *e.g.* Watson (U.S. 6,223,209 B1) disclosing distributed satellite world wide web servers containing identical information placed strategically throughout the Internet so as to be close to all potential clients to help reduce traffic bottlenecks; Midgely et. al. (U.S. 5,592,611 A) disclosing additional servers as a stand-in for a failed server so that client service requests are transparent to the user; Kriegsman (U.S. 6,370,580 B2) disclosing multiple servers as secondary web severs to optimize file transfers; Burns et. al. (U.S. 6,298,373 B1) disclosing cache servers which download content during off-peak hours to reduce traffic bottlenecks; Stiles (U.S. 6,219,692 B1) which discloses sending essentially identical tasks to multiple servers with differing processing loads to find the most preferred server provider; Zdepski et. al. (U.S. 5,825,884) disclosing an transactional server for TV networks; Burns et. al. (U.S. 6,298,373)

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7. In other words, a modification distributing the tasks between various clients and servers (e.g. having a client computer perform a task previously performed by one or two servers) is analogous to making functions, structures, or actions separable. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable. See MPEP §2144.04 V. C. and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). As noted above, it is desirable to allocate the computer tasks to various clients and servers to help reduce bandwidth bottlenecks and to help increase the benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion.

8. After careful review of the entire record, especially the specification, the Examiner finds that Applicants have not asserted in their specification any new or unexpected results regarding their hardware configuration (i.e. using the "client computer"). Absent such new or unexpected results, such modifications having either servers or client computers perform tasks or even reassigning tasks to different server(s) or client computers would have helped maintain benefits from economies of scale in addition to offering increased security, excellent data management, fast response, and room for expansion while reducing both operating and capital costs.

9. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings

disclosing how computers are used at clients to increase bandwidth by providing content in downloaded from other computers; *How Networks Work*, Chapter 17 describing how sever based structures benefit from economies of scale in addition to offering security, excellent data management, fast response, and room for expansion; and *How the Internet Works*, Chapter 44 implementing a server based architecture in Internet e-commerce.

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other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.⁶ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements⁷ with the required clarity, deliberateness, and precision.⁸ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁹ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation¹⁰ to be their own lexicographer. Finally, after receiving

⁶ See the First Non Final Office Action mailed July 29, 2003, Paper No. 9, Paragraph No. 17; the First Final Office Action mailed November 6, 2003, Paper No. 11, Paragraph No. 12; the Second Final Office Action (finality withdrawn) mailed September 30, 2004, Paragraph No. 26.

⁷ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁸ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁹ See Note 3.

¹⁰ See *Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant

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express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore, the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.¹¹

(10) Response to Argument

35 U.S.C. §112, 2nd rejection of Claim 1

Appellants' arguments, see pages 10-12, filed July 10, 2006, with respect to claim 1 have been fully considered and are persuasive. The rejection of claim 1 has been withdrawn.

35 U.S.C. §112, 2nd rejection of Claim 6

Appellants' arguments, see pages 12 and 13, filed July 10, 2006, with respect to claim 6 have been fully considered and are persuasive. The rejection of claim 6 has been withdrawn.

declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

¹¹ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

35 U.S.C. §102 (e) of Claims 1-14

1. Appellants argue that the Streetprices reference does not teach a client computer and that the Office Action “does not establish any necessity, natural result, or scientific fact to support a conclusion of inherency.”

However, the Examiner respectfully disagrees. Based on the definitions provided by the Examiner in the First Non Final Office Action (mailed July 29, 2003), Page 11, Paragraph No. 18a, it is the Examiner’s position that one person’s ‘server’ computer is another person’s ‘client computer.’ Because Appellants’ specification does not offer new or unexpected results of the client computer performing the actions instead of the server computer, such a difference is insufficient to distinguish the claims over the prior art. Thus, the Examiner finds that based upon all evidence of record, Streetprices 1/99 need not be a single server. As noted above, there are many reasons for having various client server configurations.

Further, the Examiner maintains the position that inherently disclosed elements, like directly disclosed elements, must be shown by the Examiner by a preponderance of the evidence.

2. Appellants assert that “There is no evidence whatever in the Streetprices reference that a product profile is generated in a client computer, wherein the product profile includes a URL for a given site. Also, it does not naturally or necessarily flow from the teachings of the applied reference that a product profile is generated.” Also, Appellants argue that there “is no evidence that a scan interval is included in a product profile generated in a client computer.”

The Examiner respectfully disagrees. In this case, the product identifier is the product name or description. Further the identifier/product name or description must be present in order to determine which item/product to retrieve.

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35 U.S.C. §103 (a) of Claims 1-14

1. Appellants argues that “the Web server of Bailey clearly is not a client computer, as recited in Claim 1, particularly web read in light of the present specification” and “Bailey actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a method that is performed in a client computer, as in the presently claimed invention.”

The Examiner respectfully disagrees; that is, Bailey is relied upon strictly support the parsing that is already inherent in Streetprices 1/99 (see Bailey col. 13, lines 25-29 and col. 14, lines 40-56).

Arguments in regards to Muller and Gralla

Appellants assert “in the Final Office Action, there was no citation to any specific item of information in either Muller or Gralla.”

However, the Examiner disagrees and notes that both Muller and Gralla were cited as additional evidence of what is basic knowledge or common sense to one of ordinary skill in the art (see paper no. 20060104, paragraph no. 12).

No Basis for Combining References under 35 U.S.C. §103

In response to Appellants, argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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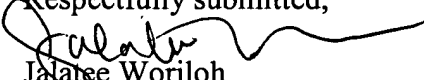
1992). In this case, Muller and Gralla are cited simply to show those features of the Internet that are old and well known in the art. Also, these references are also analogous.

(11) Related Proceeding(s) Appendix

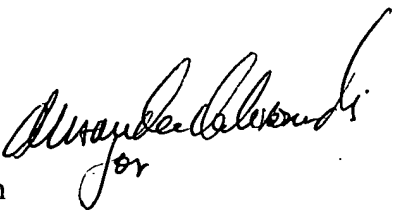
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Jalasee Worjloh
Primary Examiner
Art Unit 3621

Conferees:


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